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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,413	01/16/2004	David J. Stucky	247860US55CONT	5660

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EXAMINER	
RAJGURU, UMAKANT K	
ART UNIT	PAPER NUMBER

1711

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/758,413	<b>Applicant(s)</b> STUCKY ET AL.	
	<b>Examiner</b> Umakant K. Rajguru	<b>Art Unit</b> 1711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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1. A response (to restriction requirement) has been filed on December 10, 2004.
2. Claims 1-14 and 18-20 are presented for examination.
3. Applicant's election with traverse of group I, claims 1-14 and 18-20 in the reply filed on of December 10, 2004 is acknowledged. The traversal is on the ground(s) that (a) adequate reasons are not set forth for restriction (b) adequate examples are not provided to conclude a patentable distinctness and (c) there is no showing of a burden for search of all claims. This is not found persuasive because reasons for restriction along with showing of how and why the composite claims are distinguishable from the method claims are set forth in earlier office action of November 10, 2004. Applicants' observation that there is no burden in searching all claims is based only an assumption without any supportive evidence since search for method claims does involve additional burden.

The requirement is still deemed proper and is therefore made FINAL.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-9, 12 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 10 and 17 of U.S. Patent No. 6344268. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims encompass a composite material comprising same ingredients. Only difference is that amounts of these ingredients are very similar to one another (they are not exactly same).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1-14 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cope (US 5847016) in view of Hunter et al (US 6295777) and Giuseppe et al (US 5406768).

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Cope describes foamed polymer and wood flour or wood fiber composite formed by extrusion. Polymer can be polyvinyl chloride (abstract col 2, lines 25-27).

Composite contains additional ingredients such as lubricants and blowing agents (col 4, lines 54-62). Their amounts are given in col 8, lines 1-12. Titanium dioxide and calcium carbonate are also incorporated in the composite (col 6, lines 17, 40).

Cope is silent about (a) specific gravity and porosity and (b) addition of a blowing agent or gaseous medium to a molten precursor.

Hunter discloses an exterior finishing panel, which includes an inner layer of foamed plastic material (abstract). Polyvinyl chloride is used alongwith wood flour. A melt-enhancer such as an acrylic modifier and a chemical blowing agent or gas are used (col 6, lines 8-67).

Giuseppe also describes a polymer and wood fiber composite in which polyvinyl chloride and wood fibers are used (abstract, col 2 lines 4-21).

It would have therefore been obvious to include in the composite of Cope, (a) acrylic modifier (of Hunter) to enhance flow of the composition during processing and (b) wood fibers (taught by Giuseppe) in order to avoid accumulation of dust (if wood particles are used) which tends to be prone to catch fire.

It is noted that prior art does not expressly mention (claimed) specific gravity (of instant claims 1, 7, 10) porosity (of instant claims 1 and 6), flexural modules and specific pigment (of instant claim 20).

These limitations represent certain physical properties that are associated with a composite (such as one of prior art). One of ordinary skill in the art can always achieve

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them by appropriately varying the amounts of ingredients of the composite. Similar is the case with (a) limitation of mixing of blowing agent during extrusion (as claimed in instant claim 13 and (b) limitation (in instant claim 14) about ability to fasten screw to the surface of composite.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 is indefinite since it is not known if the specific gravity (on line 2) is that of composite or of fiber. It is also indefinite along with claim 5 in reciting "molten precursor" as containing a chemical blowing agent and an acrylic modifier. It means that the precursor does not include resin and fiber, which are the two important ingredients of chemical composite.

10. Claim 1 recites the limitation "the addition of a gaseous medium or blowing agent to a molten precursor of said composite building material" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umakant k. Rajguru whose telephone number is 571-272-1077, Monday thru Friday, from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck, can be reached on 571-272-1078. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rajguru/LR  
March 10, 2005



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700